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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,708	04/30/2001	James R.H. Challenger	Y0R9-2001-0281US1 (8728-5)	2686
46069	7590	03/10/2006	EXAMINER	
F. CHAU & ASSOCIATES, LLC 130 WOODBURY ROAD WOODBURY, NY 11797			PAULA, CESAR B	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/845,708	Applicant(s) CHALLENGER ET AL.	
	Examiner CESAR B. PAULA	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-21 and 24 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-21 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the remarks, and IDS filed on 12/23/2005, and 1/23/2006.

This action is made Final.

2. In the remarks, claims 16-21, and 24 are pending in the case. Claim 16 is an independent claim.

Drawings

3. The drawings filed on 4/30/2001 have been approved by the examiner.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 16-20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Troyansky (US Pub.# 2003/0190054 A1, 10/9/2003, Provisional application filed on 10/3/2000), in view of Takashi et al, hereinafter Takashi (US Pub. # 2002/0059162, 5/16/2002, filed on 2/8/1999), and further in view of Lemay et al, "Laura Lemay's Web Workshop Creating Commercial Web Pages", hereinafter Lemay, Sams.net, 1996, pp.110-115), and further in view

of Truong (Pat.# 6,151,609, 11/21/2000), and further in view of Levy et al, hereinafter Levy (USPub 2003/00112548 A1, 1/16/2003, provisional application filed on 12/21/2000).

Regarding independent claim 16, Troyansky teaches inserting or storing a digital watermark into digital content—*determining a content creation preference*--by replacing or converting parts of digital files, such as HTML files—*electronically encoded HTML document*--with hidden images--*watermarks*--such as image (0003). In other words parts of the text of the HTML files are extracted, and then watermarked by dynamically converting those HTML parts, which are in a textual format (as is well known, and shown by Lemay, page 112, lines 15-36), into an image.

Furthermore, Troyansky fails to explicitly disclose: *receiving a request for the content from a client; obtaining, at a server, the content in text format, automatically by the server.* However, Truong teaches an Internet server receiving an HTML file selection. In response, the Internet server communicates the HTML file in textual format to a requesting client (col.8, lines 38-53). Takashi teaches clients accessing or requesting HTML web pages information from a server (0020, 0005, 0024, 2nd parag.). Levy teaches the addition, and dynamic linking of a watermarked image in a web page at the time of rendering the web page (0094)—*generating an HTML containing a reference to the stored content in the image format for retrieval and inline dynamic assembly by the client.* It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Troyansky, Takashi, Lemay, and Truong, because Troyansky teaches enforcing digital rights of documents, such as HTML by inserting

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watermarked image files into the document (002-003). Thus, providing the benefit of protecting the obtained HTML document from unauthorized use.

Regarding claim 17, which depends on claim 16, Troyansky teaches inserting a digital watermark into digital content by replacing or converting parts of digital files, such as HTML files, which are in a textual format (as is well known, and shown by Lemay, page 112, lines 15-36), with hidden images--*watermarks*--such as image (0003). In other words parts of the text of the HTML files are extracted, and then watermarked by dynamically converting those HTML parts into an image.

Regarding claim 18, which depends on claim 13, Troyansky teaches inserting a digital watermark into digital content by replacing parts of digital files, such as image files with hidden images--*watermarks* (0003). Troyansky fails to explicitly disclose: *receiving a request for the content from a client; obtaining the content in text format*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have retrieved the image file, because Troyansky teaches enforcing digital rights of image documents, by inserting watermarked information into the document (002-003). Thus, providing the benefit of protecting the obtained HTML document from unauthorized use.

Regarding claim 19, which depends on claim 16, Troyansky teaches compressing a watermark using lossy compression algorithms--*watermarking preference* (0004, lines 6-9).

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Regarding claim 20, which depends on claim 19, Troyansky teaches compressing a watermark using lossy compression algorithms--*compression preference* (0004, lines 6-9).

6. Claim 21 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Troyansky, in view of Takashi, in view of Lemay, further in view of Truong, further in view of Levy, and further in view of Pagemill.

Regarding claim 21, which depends on claim 16, Troyansky teaches inserting a digital watermark into digital content by replacing parts of digital files, such as HTML files (0003). Troyansky fails to explicitly disclose: *the mapping preference relates selectable spatial display coordinates to external document identifiers in order to enable user navigation*. However, Pagemill teaches inserting an active image, which contains more than one URL. The image is divided into areas, setup by coordinates along with their associated URLs. When a user clicks on an area, the browser jumps to the URL—*external document identifier*-- of the respective area (page 139, lines 21-33, and fig. 6.1). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Troyansky, Takashi, Lemay, Truong, and Pagemill, because Troyansky teaches enforcing digital rights of documents, such as HTML by inserting watermarked image files into the document (002-003). Thus, providing the benefit of protecting data in the HTML document from unauthorized use.

7. Claim 24 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Troyansky, in view of Takashi, in view of Lemay, and further in view of Truong, , further in view of Levy, and further in view of Minematsu (Pat.# 6,700,993, 3/2/2004, filed on 9/6/2000).

Regarding claim 24, which depends on claim 19, Troyansky teaches inserting a digital watermark into digital content by replacing or converting parts of digital files, such as HTML files such as image (0003). Troyansky fails to explicitly disclose: *receiving a client system request for verification of the watermarked content*. However, Minematsu teaches a user terminal transmitting first transmission of watermarked information to a detection center, where the information is authenticated. The information is then transmitted to the user terminal, where the authentication result is displayed (col.3, lines 61-col.4, line 67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Troyansky, Lemay, and Minematsu, because Minematsu teaches providing a tamper resistant watermarked image for encrypting information (col. 3, lines 57-67). Thus, providing the benefit of protecting the obtained HTML document from unauthorized use.

Response to Arguments

8. Applicant's arguments filed 12/23/2005 have been fully considered but they are not persuasive. The Applicant notes that neither Troyansky, Takashi, Lemay, Truong, nor Levy teach the retrieval and inline dynamic assembly by the client of an HTML document and content (pages 5-8). The Examiner disagrees, because Levy teaches the dynamically linking or adding, from a database, of a watermarked image to a web page at render time (0094, esp. latter part). In

other words, a link is placed on the web page, so when the web page is downloaded and displayed to the user, the watermarked image would be retrieved and dynamically displayed in the web page. The web page is created by a providing-designer, but it is to be delivered to a requesting client.

Moreover, the Applicant notes that the subject matter relied upon in Levy does not appear in the provisional application it is based on. Therefore, Levy is not a proper reference under 102(e). The Examiner disagrees, because the provisional application (60/257,822) teaches the adding of watermarked images to a document, such as a web page, at render time (pages 1, lines 24-page 2, line 5, 22, 9-10). This is basically what's being stated in Levy (0094). Therefore, Levy is a valid reference under 35 USC 102(e).

Claims 17-21, and 24 are rejected at least based on the rationale stated above.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rhoads et al. (Pat. # 6,411,725, 6,947,571, and 6,614,914).

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.


Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://portal.uspto.gov/external/portal/pair>. Should you have any questions about access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866 217-9197 (toll-free).

Any response to this Action should be mailed to:
Commissioner for Patents
P.O. Box 1450

Alexandria, VA 22313-1450

Or faxed to:

- (571)-273-8300 (for all Formal communications intended for entry)


CESAR PAULA
PRIMARY EXAMINER

3/8/06